

REMARKS

Applicant requests reconsideration of the application in view of the foregoing amendments and the discussion that follows. The status of the claims as of this response is as follows: Claims 1, 4-50, 52-53 are pending in the above-mentioned patent application. Claims 2-3 and 51 were canceled previously. Claims 48-50 and 52-53 were withdrawn in the present Office Action and Claims 1 and 4-47 stand rejected. Claims 16, 24, 33 and 45 have been amended herein.

The Amendments

Claim 16 was amended to recite that the input element is adapted to move the shelves in a predetermined manner to receive packages into the apparatus and move the packages to a holder and amended also to delete reference to temperature control. Support therefor is in the Specification, for example, original Claim 1 and page 21, lines 19-22.

Claim 24 was amended to recite that the input element is adapted to move the shelves vertically in a predetermined manner to receive packages into the apparatus and move the packages to a holder. Support therefor is in the Specification, for example, page 21, lines 19-22. Claim 24 was also amended to recite that the output element is adapted to move the shelves vertically in a predetermined manner to receive a package from the circular tray. Support therefor is in the Specification, for example, page 21, lines 19-22.

Claim 33 was amended to recite that the input element provides movement of the covered packages to the movable holding device. Support therefor is in the Specification, for example, page 21, lines 19-22.

Claim 45 was amended to indicate that the input element is adapted to move the shelves in a predetermined manner to move support housings into the apparatus and move the support housings to a holding device. Support therefor is in the Specification, for example, page 21, lines 19-22. Claim 45 was also amended to recite that the output element is adapted to move the shelves in a predetermined manner to receive a support housing from the holding device. Support therefor is in the Specification, for example, page 21, lines 19-22.

Withdrawal of Claims 48-50 and 52-53

The Office Action indicated that Claims 48-50 and 52-53 were withdrawn from consideration as being directed to a non-elected invention. The reason set forth in the Office Action is that Claims 48-50 and 52-53 are directed to an invention that is independent or distinct from the invention originally claimed. The Office Action effectively has required restriction to one of two inventions identified by the Office Action, namely, the invention of Claims 1 and 4-47 and the invention of Claims 48-50 and 52-53.

The Office Action indicated that the inventions are distinct from one another. According to M.P.E.P. 802.01 the term "distinct" means that two or more subjects as disclosed are related, for example, as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made, etc., but are capable of separate manufacture, use, or sale as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER (emphasis in original). Accordingly, the Office Action is acknowledging at least implicitly that the inventions identified by the Office Action are separately patentable over one other. If this were not the case, then restriction would not be proper.

In any event Applicant reserves the right to file divisional applications to the separately patentable subject matter of Claims 48-50 and 52-53.

Rejection under 35 U.S.C. §103

Claims 1 and 4-47 were rejected under paragraph (a) of the above code section as being unpatentable over Holen in view of Panetz, *et al.*, U.S. Patent No. 5,585,088 (Panetz), Iwata, *et al.*, U.S. Patent No. 4,495,149 (Iwata) and Stylli, *et al.*, U.S. Patent No. 5,985,214 (Stylli).

The Holen reference discloses a reaction cartridge and carousel for a semi-automated biological sample analyzer that includes sub-systems to simultaneously perform a plurality of enzyme immunoassays for human IgE class antibodies specific to a panel of preselected allergens in each of a plurality of biological samples. The reaction cartridges include a test card that includes an array of test sites. The test card is contained in a reaction well that is provided with a removable cover and a reagent port for delivery and removal of fluids to and from the reaction well. The test sites on the test card are typically about 0.1 inches in diameter and separated by a moat that is 0.01 inches across.

Panetz teaches an apparatus for automatically separating at least one compound from a plurality of discrete liquid specimens. One embodiment utilizes sample preparation columns that are automatically fed to a column transport disc. The transport disc is preferably provided with compound bores that allow the columns to be easily positioned, transported past a plurality of reagent/gas dispense stations, and ejected after use.

Iwata discloses an analyzing apparatus for applying samples and reagents to the surface of a reaction carrier and for optically analyzing each component contained in the various samples. The dispensing of the samples and reagents and the optical detection operation are performed by an optics/dispensing mechanism moved relative to the reaction carrier in two dimensions. The optics/dispensing mechanism is combined with a cleaning apparatus for cleaning reagents and samples from a dispensing needle by means of a rinsing agent and air ejected toward the needle. The apparatus further includes an automatic lifting mechanism for lifting and replacing a cover disposed on the reaction carrier and is adapted to move the dispensing needle to a position over a nearby reagent/sample holder so that the needle may take up a desired reagent or sample from the holder and transfer it to the surface of the reaction carrier.

Stylli discloses systems and methods that utilize automated and integratable workstations for identifying chemicals having useful activity. Also disclosed are chemical entities and information (e.g., chemical or biological activities of chemicals) generated or discovered by operation of workstations. Also included are automated workstations that are programmably controlled to minimize processing times at each workstation and that can be integrated to minimize the processing time of the liquid samples from the start to finish of the process.

The Office Action recognizes that Holen does not teach an input means or an output means or removing the cover prior to adding fluids. The Office Action contends that it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate input and output means into the Holen device and method such as taught by Stylli because of the reduced operator interface with the device, reduced contamination and the ability for continuous operation of the device as taught by Panetz and Stylli. It would have been obvious to one of ordinary skill in the art at the time of the invention, continues the Office Action, to use notoriously well known covers and provide means to remove the covers such as

taught by Iwata or Stylli because of their well known use in preventing evaporation of fluids as taught by Iwata and if one were not concerned with the sealing advantages taught by Holen.

Applicant respectfully traverses the above rejection. With regard to Claim 1, for example, the issue is not whether using covers and removing covers would be possible. The issue is whether it would have been obvious to one of ordinary skill in the art, based on the teaching of Holen and the secondary references, to provide for removal of the cover in an apparatus to add fluid through the opening. Applicant submits that it would not have been obvious to the skilled artisan. Holen's teaching is directly contrary to such a concept. Even though Holen states that his cover may be removable, Holen does not remove it for the application and removal of fluid to and from the cartridge and his apparatus is constructed accordingly. As a matter of fact, Holen goes to great lengths to make sure that the cover provides a good seal during the addition and removal of fluids to and from his cartridge (column 10, lines 4-9, for example) and uses probes and pumps for addition and removal of fluids.

It is important to note that the Examiner is required to consider all that a reference discloses; piecemeal reconstruction of the prior art is not allowed. It is not permissible "to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art" *In re Wesslan* 147 U.S.P.Q. 91 at 394, 827 O.G. 348 at 351 (1966). In determining the scope and content of the prior art, references must be considered in their entirety, as a whole, including portions that would lead away from the claimed invention. *In re Panduit*, 810 F.2d 1561, 1 U.S.P.Q.2d 1593 (Fed Cir. 1987).

Without acquiescing in the Examiner's proposed motivation for making the combination of the teachings of the references as the Examiner has done, Applicant submits that the combined teachings do not yield the claimed inventions of Claim 16 and those claims dependent therefrom. The combined teachings of the references do not suggest an input element comprising a plurality of package holders in the form of shelves where the input element is adapted to move the shelves in a predetermined manner to receive packages into the apparatus and move the packages to a holder. None of the references discloses or suggests, either individually or in combination, an input element that is adapted to move the shelves and to move the packages to a holder as claimed in Claim 16. Stylli's modular hotels

have a plurality of fixed shelves, which do not move independent of the rack system or modular hotel. See, for example, column 19, lines 20-44, and Figs. 3 and 5 of the Stylli reference.

Claim 24 is not suggested by the combined teachings of the references because the combined teachings do not suggest an apparatus that comprises (i) an input element adapted to move the shelves vertically in a predetermined manner to receive packages into the apparatus and move the packages to a holder or (ii) an output element adapted to move the shelves vertically in a predetermined manner to receive a package from the circular tray. For Claims 25 and 26, Holen, Panetz, Iwata and Stylli do not suggest, either individually or in combination, an apparatus wherein the input element and/or the output element is an elevator system.

The combined teachings do not suggest the invention of Claim 28 because the combined teachings do not suggest removing the cover of a support housing to add and remove fluids to and from the support housing. As discussed above, Holen may be viewed as teaching away from such an approach. Accordingly, one skilled in the art would not have had the requisite motivation to combine the teachings of the references in the manner presented in the Office Action.

For reasons similar to those above, the combined teachings of the references do not suggest the method of Claim 33. There is no suggestion of moving a holding device in an indexed manner to move covered packages to a device for removing covers from the covered packages. As discussed above, Holen appears to teach away from opening his packages. Furthermore, as recited in Claim 33, the input element provides movement of the covered packages to the movable holding device. This feature is not disclosed or suggested by the combined teachings of the references.

For reasons similar to those discussed above for Claim 1, the combined teachings of the references do not suggest the embodiments of Claim 43.

Claim 45 is not disclosed or suggested by a combination of the teachings of the aforementioned references. Holen, Panetz, Iwata and Stylli do not disclose or suggest, either individually or in combination, (i) an input element adapted to move shelves in a predetermined manner to move support housings into the apparatus and move the support housings to a holding device or (ii) an output element adapted to move the shelves in a predetermined manner to receive a support housing from the holding device.

U.S. Patent Publication Documents

Applicant greatly appreciates the citation and consideration by the Examiner of U.S. Patent Publications 2002/0006359 A1 and 2002/0174884 A1, which the Office Action indicated were incorrectly cited in Applicant's IDS.

Conclusion

Claims 1 and 4-47 satisfy the requirements of 35 U.S.C. 103. Allowance of the above-identified patent application, it is submitted, is in order.

Respectfully submitted,



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